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**Datasheet for the decision
of 1 December 2017**

Case Number: T 1176/13 - 3.5.03

Application Number: 08002754.3

Publication Number: 1983767

IPC: H04W28/06

Language of the proceedings: EN

Title of invention:

Method and apparatus for enhancing transmission efficiency in
a wireless communications system

Applicant:

Innovative Sonic Limited

Headword:

Enhancing transmission efficiency/INNOVATIVE SONIC LIMITED

Relevant legal provisions:

EPC Art. 123(2)
RPBA Art. 12(2), 12(4), 13(1)

Keyword:

Amendments - allowable - main request (no)
Admissibility - first to fifth auxiliary requests (no)

Decisions cited:

G 0007/93, T 1273/04, T 0573/09, T 0556/13



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Case Number: T 1176/13 - 3.5.03

D E C I S I O N
of Technical Board of Appeal 3.5.03
of 1 December 2017

Appellant: Innovative Sonic Limited
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Decision under appeal: Decision of the Examining Division of the
European Patent Office posted on 6 December 2012
refusing European patent application No.
08002754.3 pursuant to Article 97(2) EPC.

Composition of the Board:

Chairman F. van der Voort
Members: A. Madenach
S. Fernández de Córdoba

Summary of Facts and Submissions

- I. The present appeal is against the decision of the examining division refusing European patent application No. 08002754.3, with publication number EP 1 983 767 A1. The refusal was based on the ground that the subject-matter of claim 1 of a main request was not new (Articles 52(1) and 54 EPC). No consent was given to amendments according to auxiliary requests 1 to 4 (Rule 137(3) EPC) as the amendments were not found to be clearly allowable.
- II. In the statement of grounds of appeal, the appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of the claims of a main request or, in the alternative, one of first to fourth auxiliary requests, all requests filed with the statement of grounds of appeal. As an auxiliary measure, oral proceedings were requested.
- III. In a communication pursuant to Article 15(1) RPBA, the board gave its preliminary opinion indicating, *inter alia*, that claim 1 of the main request did not appear to meet the requirement of Article 123(2) EPC and that the admissibility of the first to fourth auxiliary requests needed to be discussed during the oral proceedings.
- IV. With a letter dated 28 November 2017, i.e. three days before the oral proceedings, the appellant submitted claims of an amended main request as well as claims of a further, i.e. fifth, auxiliary request.
- V. Oral proceedings were held on 1 December 2017.

The appellant requested that the decision under appeal be set aside and that a patent be granted on the basis of the claims of the main request as filed with the letter dated 28 November 2017 or, in the alternative, on the basis of the claims of one of the first to fourth auxiliary requests as filed with the statement of grounds of appeal or the fifth auxiliary request as filed with the letter dated 28 November 2017.

At the end of the oral proceedings, after deliberation, the chairman announced the board's decision.

VI. Claim 1 of the main request reads as follows:

"A method for enhancing transmission efficiency in a wireless communications system comprising:
forming a radio link control (RLC) protocol entity operated in an unacknowledged mode (UM) and an upper-layer protocol entity;
characterized by the radio link control (RLC) protocol entity performing a duplication avoidance and reordering, called DAR hereinafter, function on a logic channel, when the DAR function is not configured by the upper-layer protocol entity."

Claim 1 of the first auxiliary request differs from claim 1 of the main request in that the characterising portion reads:

"characterized by the protocol entity performing a duplication avoidance and reordering, called DAR hereinafter, function on a logic channel, when the DAR function is configured regardless of a signalling by the upper-layer protocol entity."

Claim 1 of the second auxiliary request differs from claim 1 of the main request in that the characterising portion reads:

"characterized by the protocol entity performing a duplication avoidance and reordering, called DAR hereinafter, function on a logic channel, regardless of a configuration of the DAR function by the upper-layer protocol entity (302).".

Claim 1 of the third auxiliary request differs from claim 1 of the main request in that the characterising portion reads:

"characterized by the protocol entity performing a duplication avoidance and reordering, called DAR hereinafter, function on a logic channel, wherein the upper-layer protocol entity corresponding to a protocol entity in the wireless communications system does not output signalling for configuring the protocol entity to perform the DAR function.".

Claim 1 of the fourth auxiliary request differs from claim 1 of the main request in that the characterising portion reads:

"characterized by the protocol entity performing a duplication avoidance and reordering, called DAR hereinafter, function on a logic channel, and ignoring a configuration of the DAR function by the upper-layer protocol entity.".

Claim 1 of the fifth auxiliary request differs from claim 1 of the main request in that the characterising portion reads:

"characterized by the radio link control (RLC) protocol entity performing a duplication avoidance and reordering, called DAR hereinafter, function on a logic channel, due to supporting the DAR function on MTCH as a default without referring to a configuration of the DAR function by the upper-layer protocol entity (302)".

Reasons for the Decision

1. *Main request: added subject-matter (Article 123(2) EPC)*

1.1 Claim 1 of the main request has been amended compared to claim 1 as originally filed in that the wording

"the first protocol entity always performing a duplication avoidance and reordering, called DAR hereinafter, function on a logic channel, without referring to a configuration of the DAR function by the upper-layer protocol entity (302)" (underlining by the board)

has been replaced by:

"the radio link control (RLC) protocol entity performing a duplication avoidance and reordering, called DAR hereinafter, function on a logic channel, when the DAR function is not configured by the upper-layer protocol entity".

1.2 As a basis for this amendment, the appellant referred to page 4, third paragraph, first sentence, of the description as originally filed, which reads:

"According to the process 30, the first protocol entity

always performs the DAR function on the logic channel, and does not refer to whether the upper-layer protocol entity configures the protocol entity to perform the DAR function" (underlining by the board).

- 1.3 In the board's judgement, neither claim 1 as originally filed nor the above-cited sentence on page 4 of the description as originally filed provides a basis for the DAR function being performed **when** the DAR function is not configured by the upper layer protocol entity. The board understands "when the DAR function is not configured by the upper-layer protocol entity" in this step of performing the DAR function by the first protocol entity, i.e. the RLC protocol entity, to mean that the DAR function is performed at a point in time at which the DAR function is not configured by the upper-layer protocol entity, thus implying simultaneity of these events. No such relation between the performance of the DAR function by the first protocol entity and its non-configuration by the upper-layer protocol entity is originally disclosed. According to the application as filed, the DAR function is always performed by the first protocol entity and without reference to a simultaneous non-configuration of the DAR function by the upper-layer protocol entity (cf. claim 1 as originally filed and page 4, third paragraph, of the description as originally filed).

Hence, there is no clear and unambiguous disclosure of performing the DAR function by the RLC protocol entity being linked to a simultaneous non-configuration of the DAR function by the upper-layer protocol entity.

- 1.4 Claim 1 has therefore been amended in such a way that it contains subject-matter which extends beyond the content of the application as filed, contrary to

requirement of Article 123(2) EPC.

1.5 The main request is therefore not allowable.

2. *First to fourth auxiliary requests: admissibility (Article 12(2) and (4) RPBA)*

2.1 Claims 1 of the first to fourth auxiliary requests are identical to claims 1 of auxiliary requests 1 to 4, respectively, as submitted during the examination proceedings. Auxiliary requests 1 to 3 had been late filed, i.e. two days before the oral proceedings before the examining division, and auxiliary request 4 had been filed one month before these oral proceedings. The examining division did not admit these requests into the proceedings under Rule 137(3) EPC, stating *inter alia* that (see the Grounds for the Decision, points 2 and 3) "In each of Auxiliary Requests 1-3, the independent claims were found not to satisfy the criteria of T 1273/04 that the amendments are clearly permissible under Art. 123(2), Art. 84 and the subject-matter of the amended claims is clearly new; see Guidelines of June 2012, Part H, Chapter II, paragraph 2.7.2." and, in respect of auxiliary request 4, that "The amendments in independent claims 1 and 7 do not remedy the deficiencies in response to the preceding communications; see Guidelines of June 2012, Part H, Chapter II, paragraph 2.3.". More specifically, it stated that the independent claims of auxiliary request 1 did not, *prima facie*, meet the requirement of Article 123(2) EPC, that the independent claims of auxiliary requests 2 and 4 did not, *prima facie*, meet the requirement of novelty (Articles 52(1) and 54 EPC), and that the independent claims of auxiliary request 3 did not, *prima facie*, meet the requirements of Article 84

EPC (clarity) (see the Grounds for the Decision, points 2.1 to 2.3).

- 2.2 Article 12(2) RPBA stipulates: "The statement of grounds of appeal and the reply shall contain a party's complete case. They shall set out clearly and concisely the reasons why it is requested that the decision under appeal be reversed, amended or upheld, and should specify expressly all the facts, arguments and evidence relied on.". Further, according to Article 12(4) RPBA, the board has the power to hold inadmissible facts, evidence or requests which were not admitted in the first instance proceedings.

The board also refers to G 7/93 (OJ EPO 1994, 775) according to which "if an Examining Division has exercised its discretion under Rule 86(3) EPC [1973 (now Rule 137(3) EPC)] against an applicant in a particular case and the applicant files an appeal against the way in which such discretion was exercised, it is not the function of a Board of Appeal to review all the facts and circumstances of the case as if it were in the place of the first instance department, in order to decide whether or not it would have exercised such discretion in the same way as the first instance department. If a first instance department is required under the EPC to exercise its discretion in certain circumstances, such a department should have a certain degree of freedom when exercising that discretion, without interference from the Boards of Appeal. In the circumstances of a case such as that before the referring Board, a Board of Appeal should only overrule the way in which a first instance department has exercised its discretion if it comes to the conclusion either that the first instance department in its decision has not exercised its discretion in accordance

with the right principles as set out in paragraph 2.5 above, or that it has exercised its discretion in an unreasonable way, and has thus exceeded the proper limits of its discretion." (point 2.6 of the reasons).

- 2.3 In the present case, as already pointed out in the board's communication annexed to the summons to oral proceedings, in the statement of grounds of appeal the appellant did not, contrary to the requirements of Article 12(2) RPBA, give any reasons why the board should set aside the examining division's discretionary decision under Rule 137(3) EPC not to admit these requests. The statement of grounds of appeal contained arguments only as to why the subject-matter of the claims of the main request and the first, second and fourth auxiliary requests was novel, claim 1 of the first auxiliary request complied with Article 123(2) EPC and the independent claims of the third auxiliary request met the requirements of Article 84 EPC.

Nor did the appellant in its reply to the board's communication comment on the issue of admissibility of the first to fourth auxiliary requests as raised in this communication.

Following T 573/09 (see point 2 of the reasons), since it was neither immediately apparent to the board upon reading the decision under appeal and the statement of grounds of appeal nor argued by the appellant at any point that the examining division exercised its discretion in an unreasonable way or based it on the wrong principles, the board saw no reason to overrule the way in which the examining division had exercised its discretion.

Further, the board, exercising its own discretion under

Article 12(4) RPBA (cf. T 0556/13, points 2.1.5 to 2.1.7) saw no reason to not hold the first to fourth auxiliary requests inadmissible.

2.4 The board therefore decided to hold the first to fourth auxiliary requests inadmissible.

3. *Fifth auxiliary request: admissibility (Article 13(1) RPBA)*

3.1 The fifth auxiliary request was filed with the letter dated 28 November 2017, i.e. only three days before the scheduled oral proceedings before the board.

According to Article 13(1) RPBA, any amendment to a party's case after it has filed its grounds of appeal or reply may be admitted and considered at the Board's discretion. The discretion shall be exercised in view of, *inter alia*, the complexity of the new subject-matter submitted, the current state of the proceedings and the need for procedural economy.

3.2 Claim 1 of the fifth auxiliary request is identical to claim 1 of the main request as decided on by the examining division, except that "CCCH or" in "on CCCH or MTCH as a default" has been deleted, i.e. one of the two alternatives has been deleted. In the accompanying letter, the appellant submitted that this deletion was merely a technical correction.

In its decision, the examining division had held that the subject-matter of claim 1 of the main request lacked novelty in respect of either of these alternatives (see Grounds for the Decision, points 1 and 1.1).

3.3 As to the question of novelty and inventive step of the subject-matter of claim 1, the appellant in its letter merely referred to the arguments brought forward in respect of the main request and the first to fourth auxiliary requests. The appellant neither identified the amendments as compared to claim 1 of any one of the pending requests nor indicated the basis for these amendments (cf. Rule 137(4) EPC).

3.4 At the oral proceedings, the appellant argued that the fifth auxiliary request was filed as a reaction to the board's communication under Article 15(1) RPBA, in which objections as to added subject-matter and clarity had been raised with respect to the claims of the main request and the first to fourth auxiliary requests, all filed with the statement of grounds of appeal. Further, it pointed out that the claims of the fifth auxiliary request were, apart from the above-mentioned deletion, identical to those of the main request before the examining division and that this request was held by the examining division to comply with the requirements of Articles 84 and 123(2) EPC. Reference was made to page 2, lines 1 to 6, of the minutes of the oral proceedings before the examining division.

3.5 The board did not admit the fifth auxiliary request into the appeal procedure for the following reasons:

Firstly, the appellant did not provide arguments why claim 1 of the fifth auxiliary request overcame the examining division's novelty objection with respect to claim 1 of the then main request, i.e. the same claim, apart from the above-mentioned deletion of one of the two alternatives. The general reference in the letter dated 28 November 2017 to the arguments brought forward in respect of the main request and the first to fourth

auxiliary requests filed with the statement of grounds of appeal is not convincing, since the wording of claim 1 of each of these requests significantly differs from that of claim 1 of the fifth auxiliary request (see point VI above). The board does not therefore see how the arguments brought forward in respect of claim 1 of these other requests can have any bearing on claim 1 of the fifth auxiliary request.

Secondly, the filing of the fifth auxiliary request can not be seen as a response to a new objection raised for the first time by the board in its communication. The examining division in its decision already indicated that the independent claims of auxiliary request 1 did not prima facie meet the requirement of Article 123(2) EPC. In particular, it indicated that, in contrast to the independent claims of the request in question, according to the description as originally filed the DAR function was **always** performed (point 2.1 of the decision), thereby implying that this feature had unjustly been omitted. Since claim 1 of the main request as filed with the statement of grounds of appeal likewise did not include the feature that the DAR function is **always** performed, the board's objection raised in this respect in its communication under Article 15(1) RPBA cannot be considered as a new objection. The board further notes that in the accompanying letter dated 28 November 2017 the appellant did not give any reason as to why the claims of the fifth auxiliary request overcame the objection under Article 123(2) EPC raised by the board.

Thirdly, if the appellant intended to pursue a request, here the then main request, which the examining division allegedly indicated to meet the requirements of Articles 84 and 123(2) EPC, the need for procedural

economy requires that this request should have been submitted with the statement of grounds of appeal, see also Article 12(2) RPBA, which stipulates that the statement of grounds of appeal shall contain a party's complete case. However, none of the requests filed with the statement of grounds of appeal includes a claim which corresponds to claim 1 of the then main request. In this respect, the board notes that in the accompanying letter dated 28 November 2017 the appellant did not give any reasons as to why the request was filed as yet at this late stage.

Fourthly, the board saw no other reasons which could have justified the admission of the fifth auxiliary request at this late stage.

3.6 For these reasons, the fifth auxiliary request was not admitted into the appeal procedure.

4. Since the main request is not allowable and none of the further requests was admitted into the appeal procedure, the appeal is to be dismissed.

Order

For these reasons it is decided that:

The appeal is dismissed.

The Registrar:

The Chairman:



G. Rauh

F. van der Voort

Decision electronically authenticated